UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT		ATTORNEY DOCKET NO.
06/858,040	05/01/86	YAMAMOTO	M	HAW-1950C

WEGNER & BRETSCHNEIDER
P. O. BOX 18218
WASHINGTON, DC 20036

EXAMINER	
NIELSEN, E	
ART UNIT	**PAPER NUMBER**
153	5

DATE MAILED: 12/10/86

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-14 are pending in the application.
   Of the above, claims 12-14 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-10 are rejected.
5. ☒ Claims 11 ~~are~~ 15 objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

15.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, drawn to a polyester, classified in Class 528, subclass 361.

II. Claims 12-14, drawn to microcapsule compositions, classified in Class 424, subclass 78.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as product and process of use.

> The inventions are distinct if either (1) the process for using the product as claimed can be practiced with another and materially different product, or (2) the product as claimed can be used in a materially different process of using the product. MPEP 806.05(h).

In this case, the polyesters of Group I can be used as sutures, bone implants, etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Helmuth Wegner on November 24, 1986 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in responding to this Office action.

Claims 12-14 are withdrawn from further consideration by the examiner as being drawn to a nonelected invention. See 37 CFR 1.142(b).

16.

Claims 4-10 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of the words "removing ..... using water" is too vague. It includes extraction with water and steam distillation. Terms such as "washing", "extracting", or, at least, "contacting", are suggested.

17.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at

the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-3 are rejected under 35 U.S.C. 103 as being unpatentable over De Prospero.

De Prospero discloses the desirability of and a method for removing low molecular compounds from polyglycolic acid. The some method would suggest itself to polylactide, i.e. polylactic acid, and for the same reasons. The result would be a product which meets the claim limitations, i.e., low in low. M.W. materials.

18.

Claims 1-3 are rejected under 35 U.S.C. 103 as being unpatentable over Casey et al.

Casey et al. also disclose treatment with heat at low pressure of polyglycolic acid. The result is a higher M.W. product having a low content of low M.W. compounds. Again, it would be obvious to perform the same method on polylactic acid or on glycolic-lactic copolymers. The patentability of a product does not depend on its method of production. See In re Thorpe, 227, USPQ 964 (CAFC, 1985) and In re Fizgerald et al., 205 USPQ 594 (CCPA, 1980).

19.

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4-10 are would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112. 20.

References A, C, and E are cited as art of interest.

Nielsen:dl
(703) 557-6525
12-04-86
12/08/86

Earl Nielsen
EARL NIELSEN
PATENT EXAMINER
ART UNIT 153